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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/368,828 08/05/99 MASHINSKY

A 9118-037

020583
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NEW YORK NY 10036-2711

LM02/0908

EXAMINER

TIEU, B

ART UNIT	PAPER NUMBER
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2743

DATE MAILED:

09/08/00

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

TD

Office Action Summary

Application No.
09/368,828

Applicant(s)
MASHINSKY et al.

Examiner
Binh K. Tieu

Group Art Unit
2743



☒ Responsive to communication(s) filed on Aug 5, 1998

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-37 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-37 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 & 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the claim recites the limitations “brokering a transaction that effects a transfer of ownership of the offered telecommunications service from the seller to the buyer” are not clearly described in the specification. The specification, on lines 13-18, page 8, discloses only service node 106 the brokers the transaction between the parties transferring the subject telecommunications services from the seller to the buyer. That passage of specification does described enough the limitations of transferring ownership of the offered telecommunications service from the seller to the buyer as recited in the claim 1. Therefore, the Examiner respectfully requests the Applicants to point out wherein the specification described such limitations without amending the specification.

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Claim Objections

3. Claims 1-11 are object with the reasons set for in section 2 above. For examination purpose only, the Examiner assumes that the limitations "brokering a transaction that effects a transfer of ownership of the offered telecommunications service from the seller to the buyer" is described somewhere in the specification.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-11 are rejected under the judicially created doctrine of double patenting over claims 1-11 of U. S. Patent No. 6,005,926 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as

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follows: **A method of trading telecommunications services comprising the step of brokering a transaction that effects a transfer of ownership of the offered telecommunications service from the seller to the buyer.**

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 12-17, 28, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (US. Pat.#: 5,790,642 as cited in the IDS 1449 form) in view of Henrick et al. (US. Pat.#: 5,999,598).

Regarding claims 12, 28 and 37, Taylor et al. ("Taylor") teaches a competitively bidding service centers and a method for trading telecommunications services or for providing a telecommunications sale. Taylor teaches that the center 102 as shown in figure 1 provides services to its subscribers such as fax machines 113a connected to it (col.4, lines 41-49). Taylor further teaches that the center 102 acts as a "service node" or "broker" that receives service requests from the fax machines 113a and formatted into bid requests included parameters of telephone number of destination terminal, length of call, time, and other cost factors or required information (col.4, lines 60-67). Thus, the requested service is either defined as data call or voice call service. The 102 then transmits the bid requests to other centers 101, 103, 104 (col.5, lines 1-4). At this point, it should be noticed that the center 101 serves a plurality of fax machines, therefore, it must stores all copies of bid requests related to each of the fax machines for later matching corresponding information transmitted back from the other centers. Taylor further teaches the center 101 receives sell orders from the centers 101, 103 and 104 (seller) (col.5, lines 12-12-14). Taylor so far teaches the features of defining classes for telecommunications services

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(e.g., data calls or voice calls), acquiring from a buyer (e.g., fax machines 113s) and seller (e.g., centers 101, 103, 104) and sell and purchase orders (e.g., bid requests and cost of call offers provided from the centers), verifying the seller's telecommunications service parameters (e.g., cost, time, etc.) And storing the sell and purchase orders electronically (e.g., for later matching each others). Taylor further teaches that the center 102, upon receipt of all bids from the other centers, selects the lowest bidding service center to make or route the call (col.5, lines 19-19). Thus, Taylor also teaches the features of pooling sellers' telecommunications services and automatically identifying a seller's telecommunications service that satisfies the buyer's telecommunications service purchase order based on the sell and purchase orders; and enabling interconnection node or nodes between the seller and the buyer according to a pre-determined bilateral agreement.

It should be noticed that Taylor teaches the bid request included factors as required. Taylor fails to clearly teaches the bid request included a grade of service selected by an user. However, Henrick et al. ("Henrick") teaches those features in col.3, line 57 - col.4, line 3; col.4, lines 21-35 for a purpose of providing good service quality with money savings to user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a grade of service selected by an user, as taught by Henrick, into view of Taylor in order to improve offered telecommunications services to telecommunications subscribers.

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Regarding claim 13, Taylor further teaches the information included in the bid request comprising parameters such as time and values such as duration or length of time, and other factors (col.4, lines 62-67). Thus, Taylor teaches the step of defining classes includes choosing a set of class parameters and the values for the parameters.

Regarding claim 14, Taylor teaches the other factors included in the bid request. Henrick further teaches grade service included in telecommunications service request (e.g., modified directory number, (MDN); col.3, line 57 - col.4, line 3). Thus, Taylor and Henrick, in combination, teaches the feature of defining grades includes specifying weighting factors for the grade parameters.

Regarding claims 15-16, Taylor further teaches the center 102 operating as an input templates on a secure network site (e.g., New York network site, col.4, lines 10-12). The center 102 receives input from the fax machines 103a and formatted into the bid requests and transmits to the other centers 101, 103 and 104. The center 102 also receives cost of offer telecommunications service from sellers (e.g., centers, 101, 103 and 104; col.4, line 60 - col.5, line 28). Thus, Taylor teaches the limitations of the claims as recited.

Regarding claim 17, Henrick further teaches the limitations of the claim in col.5, line 65 - col.6, line 3.

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8. Claims 18-27 and 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (US. Pat.#: 5,790,642 as cited in the IDS 1449 form) in view of Henrick et al. (US. Pat.#: 5,999,598) as applied to claim 12 above, and further in view of Gell et al. (UK Pat. No. WO 94/28683 as cited in the Applicant's IDS 1449 Form).

Regarding claims 18-21, Taylor and Henrick disclose all subject matter as claimed above, except for the step of periodically verifying the classes (e.g., channel types, bit rate, etc.) of the telecommunications services available for sale or being used by a buyer. However, Gell et al. ("Gell") teaches those features in page 25, lines 10-24 for a purpose of trade bidding.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features of periodically verifying the classes (e.g., channel types, bit rate, etc.) of the telecommunications services available for sale or being used by a buyer, as taught by Gell, into view of Taylor and Henrick in order to match each of bidding requests to each of bidding offers in the telecommunications services bidding market.

Regarding claims 22 and 27, it is well-known to those skilled in "auction rules" that, for example, a buyer agreed to purchase a bid merchandise with an offered price from a service provider, if the buyer lately changes mind not to purchase such merchandise with that offered price. The buyer may lose his partial or entire security deposit. Thus, the partial or entire security deposit is considered as a penalty. In the same manner, if the service provider can not support an offered service in agreement with a buyer in an auction, the service provider must replace the offered service with the equal or better service to buyer. If the service provider can

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not replace such offered service, the service provide, of cause, must pay for a penalty if its service is reassigned to a lower class. Therefore, it would have been obvious to those skill in the art at the time the invention was made to incorporate the use of penalty against a seller if its service is reassigned to a lower class, into view of Taylor, Henrick and Gell in order to satisfy the buyer.

Regarding claim 23, Gell further teaches the limitations of the claim on page 22, lines 24-31.

Regarding claim 24, Gell further teaches that a service provider (e.g., long distance telecommunications network 2 as shown in figure 1) wants to sell its available resource and outputs a resource indication signal. The service provider further comprises a selection device to calculate an initial price. The service provider sends the calculated initial price to each of the bidding devices located in each of local networks 1. Each of bidding device receives the resource signal and calculates the price which it will be bid for the resource. Each of bidding device compares the received price with its own calculated price. If the received price is higher than its own calculated price, the bidding device does not send a signal indicating acceptance to the service provider. The service provider does not receive any acceptance signals from bidding devices within a predetermined time, the service provider recalculated a lower price (page 27, line 9 - page 28, line 10). Similarly, if a first purchase order from a buyer is not matched or identified, a second purchase order is inputted with price increment. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of

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second purchase order when no match is identified, into view of Taylor, Henrick and Gell in order to provide opportunity to user of gaining telecommunications services from a service provider.

Regarding claims 25-26, Gell further teaches the limitations of the claim on page 21, lines 34-36; on page 22, line 24 to page 23, line 7.

Regarding claim 29, Gell further teaches the limitations of the claim as noted the database node 905 in figure 13.

Regarding claims 30-31, Gell further teaches the communication line including intercontinental communications channels via satellites, or subsea or transcontinental cables to a distant station 3 (page 5, lines 33-37). Thus, it should be obvious to one of ordinary skill in the art at the invention was made to utilize Internet connection and Web site into view of Taylor, Henrick and Gell in order to access to remote bidding service node.

Regarding claims 32-34, Gell teaches the plurality of types (e.g., telecommunications voice service providers/buyers, telecommunications video service providers/buyer, good and service providers/buyers, etc.) sellers and buyers in different telecommunications services markets. Each of service providers approved on each purchase orders from buyers. Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to incorporate the use of features of provider/buyer being not a telecommunications carrier, into view of Taylor, Henrick and Gell in order to provide opportunity to the non-telecommunications carrier to make investments in telecommunications services markets.

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Regarding claims 35-36, Gell further teaches the limitations of the claim on page 30, line 18 to page 31, line 1.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Binh K. Tieu** whose telephone number is **(703) 305-3963**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Curtis Kuntz**, can be reached on **(703) 305-4708**.

Any response to this action should be mailed to:

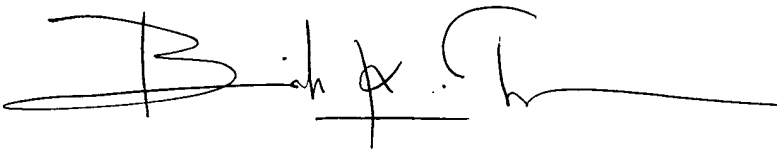
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or faxed to:

(703) 308-6306 or (703) 308-6296

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Patent Examiner

A handwritten signature in black ink, appearing to read 'Binh K. Tieu', with a long horizontal line extending to the right.

BINH K. TIEU

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Date: Sep. 05, 2000